



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/806,127

03/23/2004

Akira Hirose

119191

2111

25944 7590 10/01/2008

OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER

VO, TED T

ART UNIT

PAPER NUMBER

2191

MAIL DATE

DELIVERY MODE

10/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/806,127	Applicant(s) HIROSE ET AL.	
	Examiner TED T. VO	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the communications filed on 06/25/2008.

Claims 5-8, 10-16 are pending in the application.

Response to Arguments

2. This is in response to the argument remarks filed on 06/25/2008.

-With regards to claims rejected under 35 USC 112, second paragraph, See Examiner's rejection rationale below.

- With regards to the argument to the claims rejected under 35 USC 101, See Examiner's rejection rationale below.

-With regards to claims rejected under 102(a) being anticipated by Oracle, Applicants argued Oracle does not teach a "storage part that stores an instruction form" that indicates a process to be executed to a document or a generation part that generates an instruction form that indicates a process to be executed to a document, as recited in the pending claims, or a copying part in combination with all of the features recited in claim 8:

(Remarks: "Oracle does not teach a storage part that stores an instruction form that indicates a process to be executed to a document by at least one of a plurality of instruction form execution apparatuses connected to the instruction form management apparatus, as recited in claim 5, and similarly recited in claim 14; a generation part that generates an instruction form that indicates a process to be executed to a document by the

Art Unit: 2191

at least one instruction form execution apparatus, as recited in claims 8 and 11, and a copying part, as recited in claim 8 and now-canceled claim 9”.

See Examiner' rejection rationale below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-8, 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 5-8, 10-16: With regard to the limitation “**instruction form**”, this limitation is indefinite. The term “instruction form” is used as an essential element in the claims but the specification fails to indicate a clear meaning for it. Therefore, it renders the claims ambiguous. The specification shows only a piece of XML document, but the claims connect it as “instruction form”. This piece XML is seen common in the art. Without particularly pointing out, the interpretation for “**instruction form**” is merely a piece of XML document.

With regard to the limitation “a storage part that stores an instruction form”, this limitation is indefinite. When the claimed preamble broadly recites “An instruction form management apparatus” (Claims 5-7), or An Instruction form management system (Claims 8, 10-

Art Unit: 2191

16), the apparatus or system of the claims will not limit to a hardware system if there is no further identified limitation connecting to the hardware system. Thus, the function of “storage part” can be any container for holding so called “instruction form”, i.e. a text of XML document. Since this limitation can be interpreted with many different things, it fails to particularly point out and distinctly claim a subject matter.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The claims 5-8, 10-16 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 5-7: The claims recite “an instruction form management apparatus”. The claims asserts with “a storage that stores an instruction form”. However, the claimed preamble, as well as its body, links to no hardware entities. The storage part as claimed does not limit it within a hardware element. The storage covers a software element, such as a file added with user input parameters filled from the text areas.

As per Claims 8, 10: As the same reason as of the claims 5-7, the claims 8, 10 recite an instruction form management system without connecting to a hardware element. The claims are further added with "connected via a network". However, the term "a network" implicitly covers a

Art Unit: 2191

general entity of an environment, where this environment is not necessary as a cluster of computers. Therefore, system remains covering the software per se.

As per Claims 11-13, and 14-16: The claims clearly cover the software per se because no links to hardware elements.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 5-8, 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Oracle, “Oracle9i Case Studies – XML Applications”, June 2001.

Given the broadest reasonable interpretation of followed claims in light of the specification.

Art Unit: 2191

As per Claim 5: ORACLE discloses,

An instruction form management apparatus comprising (See p. 8-30, Figure 8-5: Section Retailer):

a storage part that stores an instruction form that indicates a process (Interpreted as a part of memory such as retailer-supplier database. The database stores and XML order, i.e. *an instruction form*, which is an XML document with tags defining a process, i.e. how to order (Figure 8-5, p. 8-30)) ***to be executed to a document by at least one of a plurality of instruction form execution apparatuses connected to the instruction form management apparatus via a network*** (See the execution such as the execution Figure 8-14, p.8-44 to p.8.47, when execution, it creates a XML document under a .bat file as of figure 8-18, p. 8-71. These execution files will be either updated or deleted because it is depending only on the user ID and User inputs. For example, ID = 526, and Quantity = 1. This is obvious. It does not need any reference to use the language “delete” when another user with different ID inputs with a deferent quantity. It is obvious that if said another user, for example ID =1, inputs a quantity = 2, then the broker.bat or Supplier.bat shown in Figure 8-18 is no longer in the database anymore, but a new Broker.bat or Supplier.bat that is corresponding to ID =1, and quantity=2 will used to run the execution order/supply);

an output part that outputs the instruction form to the at least one of the plurality of instruction form execution apparatuses (For example the bat file in Figure 8-18, or see Figure 8-5, i.e. the XML order from Retailer Database R, this XML order is filled in by user, and transformed by XSQL Servlet into the “XML order”, then sent to Supplier by the user’ click on the “Place Order”); and

Art Unit: 2191

a deletion part that causes the instruction form to be deleted from the storage part and from the at least one of the plurality of instruction form execution apparatuses when the process indicated in the instruction form has been completed (Using SQL script to deletes the orders, i.e. instruction forms', from Retailer-supplier database Customers table (see, p. 8-28)).

As per claim 6: Oracle discloses,

The instruction form management apparatus according to claim 5, further comprising a determination part that determines whether or not the instruction form includes information to delete the instruction form when the at least one of the instruction form execution apparatuses completes execution of the process indicated in the instruction form, wherein the deletion part deletes the instruction form if the instruction form includes the information to delete the instruction form.

See all the Figures 8-15 and 8-16, the Figures show the returns with result of completion or provided the user with the validation or cancel. Figure 8-16 also shows the Order Form filled with the user input no longer in the Retailer Database R. It should be noted that the deletion is perform as seen based on batch mode processing, or from the corresponding customer ID/quantity shown in the bat file (i.e. instruction form). It is deleted by means of using the SQL script.

As per claim 7: Oracle discloses,

The instruction form management apparatus according to claim 6, wherein the information to delete the instruction form indicates that the instruction form is executed only once.

See the bat file, the form is executed only one based on quantity order, and the batch mode processing, when a user performs login or fills with new order.

Art Unit: 2191

As per claim 8: reads on Oracle mechanism that using the script to generate XML document as bat file, for execution in form of a customer order/supplier.

Regarding:

An instruction form management system comprising at least one instruction form execution apparatus and an instruction form management apparatus (Using SQL) connected via a network, wherein the instruction form management apparatus comprises: a generation part that generates an instruction form that indicates a process to be executed to a document by the at least one instruction form execution apparatus, and an output part that outputs the instruction form to the at least one instruction form execution apparatus, and wherein the at least one instruction form execution apparatus comprises: an instruction form reception part that receives the instruction form and a document which is an object of the process, an execution part that executes the process indicated in the instruction form to the document, and a deletion part that deletes the instruction form from the instruction form execution apparatus when the execution part completes the execution of the process indicated in the instruction form, and

See rationale addressed in Claim 5.

Art Unit: 2191

Regarding, *a copying part that forms at least one copied instruction form by copying the instruction form* (the mechanism that hold an XML document in the database until the XML is deleted by the batch processing or SQL script), *wherein the deletion part deletes all the copied instruction forms*. See

As per Claims 10, 11-13, 14-16: Oracle discloses the claimed limitations because the claims have the functionality in the same manner as the functionality as recited in Claims 5-7.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private

Art Unit: 2191

PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV
September 19, 2008

/Ted T. Vo/
Primary Examiner, Art Unit 2191